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| 10/625,960      | 07/24/2003  | Johannes Ruetschi    | 2003P04023 US       | 1613             |

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| EXAMINER |
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RIDER, JUSTIN W

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2626

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09/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/625,960 | <b>Applicant(s)</b><br>RUETSCHI, JOHANNES |  |
|                              | <b>Examiner</b><br>JUSTIN W. RIDER   | <b>Art Unit</b><br>2626                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Response to Amendment*

1. In response to the Office Action filed 15 February 2008, the applicant has submitted an amendment, filed 14 May 2008, arguing to traverse the art rejection based on the limitation of inserting an annotation into an original message. Applicant's arguments have been fully considered, however the previous rejection is maintained due to the reasons listed below in the response to arguments section.

The examiner apologizes for the typographical error, all of the 35 U.S.C. §102(e) rejections from the previous office action should have been 35 U.S.C. §102(e) rejections over **SPIELBERG**, not **PIZANO**.

### *Response to Arguments*

2. Applicant's arguments filed 14 May 2008 have been fully considered but they are not persuasive. Applicant remarks that the insertion of annotations of **SPIELBERG** is not the same as the insertion of annotations as claimed in claims 1 and 21. The examiner does not agree.

Applicant argues that the claimed invention *inserts* an annotation into an original message, whereas **SPIELBERG** creates an annotation and later inserts said file into original document. After reviewing the instant specification, page 5, lines 27-32 state the following:

*'The annotated speech is detected by the ASR at 240 and then gets converted to text using the Speech-to-Text conversion at 250. Natural Language Processing (NLP) may be used to improve the accuracy of the Speech-to-Text translation. Alternatively, **the annotated speech at 240 is saved as a sound file at 250**. In one embodiment of the invention, the user may request to have the annotated information be read back for verification. Further, the caller may accept, reject or edit the annotation. **When the caller completes the annotation, the text of the***

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***annotated speech (or the sound file) is inserted in the original message at 260.*** '  
[emphasis supplied]

Therefore, it would seem that from applicants' own disclosure that a sound file of an annotation is created, stored and then later re-aligned with the original message.

Please see **SPIELBERG**, Figure 5 for an overview of the annotation engine, which is responsible for inserting said annotation into original message.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5, 7-10, 12-18, 21-22, 25, 27-30 and 32-38 are rejected under 35

U.S.C. 102(e) as being anticipated by **Spielberg (US 2002/0129057 A1)** referred to as

**SPIELBERG** hereinafter.

*Claims 1 and 21:* **SPIELBERG** discloses a method and apparatus for inserting a user's speech annotations into a message (page 1, paragraph [0018], '*a system that enables people to add verbal annotations (i.e. add comments) to a digital document such as a movie script, book, or any other type of document.*'), comprising:

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i. providing a speech rendering of said original message (page 1, paragraph [0018], *'The system can read documents (e.g., via a text-to-speech engine) so that the reviewer can hear the contents of the document.'*);

ii. annotating said speech message with at least one speech annotation (Figure 5; page 1-2, paragraph [0018], *'The system also provides the reviewer with a way to record verbal comments about the document.'*); and

iii. inserting said speech annotation into said original message (page 2, paragraph [0018], *'When a comment is supplied the comment becomes associated with the location in the document where the comment was provided. If, for example, the reviewer makes a comment about a particular passage of text, the comment becomes associated with the passage of text the comment is related to.'*).

Claims 2 and 22: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above wherein said original message is a text E-mail message (Abstract, *'to review and add any number of annotations (i.e. add comments) to a digital document such as movie scripts, books, etc.'* As it is well-known, E-mail messages are electronic by nature, therefore, **SPIELBERG** implicitly states the availability of using the system to annotate E-mail messages. See also page 5, paragraph [0052]) provided by accessing a Unified Messaging [Document] server (page 5, paragraph [0045]) and retrieving said text email message (page 5, paragraph [0045]).

Claims 5 and 25: **SPIELBERG** discloses a method and apparatus as per claims 2 and 22 above wherein said step of providing a speech rendering of said original message comprises converting said text message to speech (page 1, paragraph [0018], *'The system can read*

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*documents (e.g., via a text-to-speech engine) so that the reviewer can hear the contents of the document.').*

Claims 7 and 27: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of connecting to the mailbox of said email message by establishing a voice connection using a landline telephone or a mobile telephone (page 5, paragraph [0051], [0052]).

Claims 8 and 28: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above wherein said annotating step includes recognition of predefined commands for starting and stopping said speech annotation (page 4, paragraph [0044] and page 5, paragraph [0046]).

Claims 9, 12, 29 and 32: **SPIELBERG** discloses a method and apparatus as per claims 8 and 28 above, wherein a user has the capability to interact with a system using predetermined commands (page 6, paragraph [0055]) and wherein said commands are user-defined speech commands (page 6, paragraph [0055], Other playback control functions can be added to optimize user capabilities.).

Claims 10 and 30: **SPIELBERG** discloses a method and apparatus as per claims 8 and 28 above wherein said commands are entered via Dual Tone Multi-Frequency (DTMF) tones (page 5, paragraph [0050]).

Claims 13 and 33: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of recognizing said speech annotations of said caller (page 1-2, paragraph [0018], *'The system also provides the reviewer with a way to record verbal comments about the document.'*; page 5, paragraph [0052]).

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Claims 14 and 34: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of converting said speech annotations to text (page 7, paragraph [0066]).

Claims 15 and 35: **SPIELBERG** discloses a method and apparatus as per claims 14 and 34 above wherein said step of converting annotated voice command to text is accomplished using Automatic Speech Recognition (ASR) and Speech-to-Text conversion (page 7, paragraph [0066]).

Claims 16 and 36: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, wherein said speech annotation is inserted in said original message as a text file (page 7, paragraph [0066], *'converts the recorded data to proper format for storing...the comments may also be converted to text...'*).

Claims 17 and 37: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, wherein said speech annotation is inserted in said original message as a sound file (page 7, paragraph [0066], *'converts the recorded data to proper format for storing...the comments are stored as sound data...'*).

Claims 18 and 38: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of storing said annotated message at the Unified Messaging server after inserting said speech annotation into said message (page 7, paragraph [0066], *'before saving the comments in the data structure.'*).

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4, 6, 11, 20, 23-23, 26, 31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG** in view of **Pizano (EP 0 865 189 A2)** referred to as **PIZANO** hereinafter.

Claims 3 and 23: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above however failing to, but **PIZANO** does specifically disclose wherein said original message contains at least one attached document (page 2, lines 22-26, Fig. 16).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 4 and 24: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above wherein original message is a voice message (page 2, lines 29-33) provided by accessing a Unified [Universal] Messaging server (Abstract) and retrieving said voice message (Abstract, p. 2, lines 17-22).



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Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 6 and 26: **PIZANO** discloses a method and apparatus as per claims 3 and 33 above wherein said step of providing a speech rendering of said original message comprises converting said attachment to speech (page 2, lines 34-36, ‘controls a media converter which converts media to fax or *media to audio and an audio/fax player*,’ [emphasis supplied]).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 11 and 31: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of using an interactive voice response (IVR) (page 5, lines 31-55 discloses wherein a prerecorded voice interactively responds to commands spoken and entered via DTMF by a user.).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it

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provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 20 and 40: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of forwarding said annotated message to another user (page 4, line 29, *'which delivers it as a voice message to the originator.'*).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

7. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG**.

Claims 19 and 39: **SPIELBERG** discloses a method and apparatus as per claims 18 and 38 above, however failing to distinctly disclose wherein a new copy of an annotated message is created with inserted annotations (It appears as though the newly added language appears to merely re-iterate what was already being claimed [i.e., 'storing said annotated message']). **SPIELBERG** does disclose wherein an annotated message (which would inherently include the message along with any annotations.) is saved for use later.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create another copy since it was known to one possessing ordinary skill in the art that if the capability to save a document or message is present, it is common knowledge within the computing arts that it is also possible to recreate said document a multitude of times.

One of the key advantageous features of digital storage is the constant reproducibility of results useful in 'backing up' important documents. This allows for the storage of a master copy on a server in the event that an important annotated message becomes lost or corrupted, while still providing other copies to be distributed to the people of which the message was originally intended.

8. Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG** in view of **Fuller (US Patent No. 5,754,844)** referred to as **FULLER** hereinafter.

Claims 41-42: **SPIELBERG** discloses a method and apparatus as per claims 18 and 28 above, however failing to but **FULLER** does specifically disclose querying a user to either overwrite a file or to save as a new copy and subsequently performing said task based on user request (col. 8, lines 38-47).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **FULLER** in the system of **SPIELBERG** because prompting a user as to whether a new file should be saved in a different location as opposed to overwriting an older file is a well-known technique in computer processing. This serves either to conserve storage space when an older file is obsolete or to create a large amount of saved data for backup purposes at the expense of storage capacity.

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***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN W. RIDER whose telephone number is (571)270-1068. The examiner can normally be reached on Monday - Friday 6:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/  
Supervisory Patent Examiner, Art Unit 2626

/J. W. R./  
Examiner, Art Unit 2626  
11 September 2008